

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

PALM-3559.SG

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Application Number

09774990

Filed

2001-01-30

First Named Inventor

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Art Unit

2629

Examiner

Nguyen, Jennifer T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

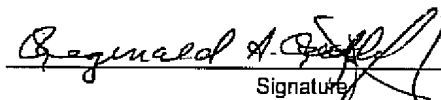
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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August 12, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action dated June 12, 2008, Applicants respectfully request a review of the final rejection in the above-identified application. Applicants respectfully submit that the rejections of the Claims 1-20 made in the aforementioned Office Action are improper as an essential element needed for proper prima facie rejections is missing (e.g., the teaching of all of the recited claim limitations). Moreover, as it regards the rejection of Claim 16, Applicants submit that this rejection is additionally improper because an explanation of how identified limitations of Claim 16 are met by the cited references have not been provided at all. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' prior art Figure 1 in view of Takahata et al. (US Patent No. 6,556,189).

### CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED REFERENCES

Applicants' prior art Figure 1 and Takahata, either alone or in combination fails to teach or suggest the embodiments of Applicants' invention as set forth in Claims 1, 9 and 16. In particular, Applicants' prior art Figure 1 and Takahata, either alone or in combination do not teach or suggest an integrated enclosure touch screen assembly that includes "a single piece cover enclosure for said touch screen assembly that is disposed over and encloses the top and sides of said touch screen assembly that has endpoints that are coincident with a bottom surface of said touch screen assembly" as is set forth in Claim 1 (Claim 9 recites similar limitations). Furthermore, Applicants' Figure 1 and Takahata either alone or in combination does not teach or suggest "a bezel-less cover element disposed over a top surface of said digitizer mechanism that has a top surface that is coincident with the top surface of a supporting structure of said bezel-less cover element" as is recited in Claim 16.

Claim Limitations That Have to do With a Single Piece Cover Enclosure That has  
Endpoints That are Coincident With a Bottom Surface of the Recited Touch Screen  
Assembly not Met by the Cited References

Applicants' prior art Figure 1 shows a touch screen assembly that clearly does not include a single piece cover enclosure that is disposed over and encloses the top and both sides of the touch screen assembly and the protective film of the shown digitizer mechanism. Referring to Applicants' Figure 1, the outermost protective film 110 which is equated in the outstanding Office Action to the recited single piece cover enclosure, does not enclose the top and fully cover both sides of the touch screen assembly shown in Figure 1. In fact, protective film 110 is limited to the area located directly above the shown digitizer mechanism (see Figure 1). Accordingly, Applicants' Figure 1 fails to teach or suggest the above noted limitations of Claims 1 and 9.

Takahata et al. does not teach or suggest a modification of Applicants' prior art Figure 1 that would remedy the deficiencies of Applicants' prior art Figure 1 outlined above. More specifically, Takahata et al. does not teach or suggest an integrated enclosure touch screen assembly that includes "a single piece cover enclosure for said touch screen assembly that is disposed over and encloses the top and sides of said touch screen assembly that has endpoints that are coincident with a bottom surface of said touch screen assembly" as is recited in Claim 1 (Claim 9 recites similar limitations).

Takahata et al. teaches a touch panel device (see abstract) that is dissimilar to embodiments of Applicants' present claimed invention. It should be noted that structure 43 of Takahata et al. is equated to the single piece cover enclosure of Claim 1 in the outstanding Office Action. However, as is discussed in Takahata et al. with reference to Fig. 9, structure 43 is a bag that is very different from the single piece cover enclosure of

Applicants' Claims. In Takahata et al. as shown in Fig. 9 and Fig. 10, bag 43 encloses the touch panel component and is sealed at the side of the touch panel component (see figures 9 and 10). Accordingly, the endpoints of bag 43 are not coincident with a bottom surface of the disclosed touch panel. This is very different from the recited single piece cover enclosure of Claims 1 and 9 that has endpoints that are coincident with a bottom surface of the recited touch screen assembly. To summarize, in Takahata et al. a single piece cover enclosure doesn't cover the top and sides of the disclosed touch panel with endpoints that are coincident with a bottom surface of the disclosed touch panel because the endpoints of the disclosed bag, which is equated to the recited cover enclosure, is disclosed to be either sealed or fused at the right side of the disclosed touch panel.

In the Office Action at page 3, it is contended that to modify Takahata et al. to include a cover enclosure whose endpoints are coincident with the bottom surface of the disclosed touch panel would be a matter of design choice. Applicants believe that this contention constitutes a clear error in the rejection as modifying any of the embodiments of the Takahata et al. device in this manner would require a wholesale rearrangement of enclosure components of the disclosed devices in a manner that would destroy an essential principle of their design. For example, the embodiments of Takahata et al. all employ some type of undivided lower support body whose bottom surface serves as the bottommost surface of the devices. Modifying, Takahata et al. such that the endpoints of its cover enclosure are coincident with the bottom surface of the disclosed touch panel would destroy this single piece "lower support body" (see structure 7 of Fig. 1 of Takahata et al.) concept that is part and parcel of the Takahata et al. design. Thus, a modification of Takahata et al. as proposed in the Office Action, would result in an enclosure structure that is based upon a design principle that is at odds with that which is actually disclosed by Takahata et al. For this reason such a modification would not be

obvious and the prima facie case presented in the outstanding Office Action that is based upon such is deficient.

Claim Limitations That Have to do With a Bezel-less Cover Element That is Coincident  
With a Supporting Structure of the Bezel-less Cover Element

In addition to the limitations discussed above, Applicants' prior art Figure 1 and Takahata et al., either alone or in combination fails to teach or suggest "a bezel-less cover element disposed over a top surface of said digitizer mechanism that has a top surface that is coincident with the top surface of a supporting structure of said bezel-less cover element as is recited in Claim 16. Referring to Applicants' Figure 1, the top surface of the device is depicted as not being coincident with the top surface of its supporting structure. As such, this structure cannot reasonably be equated to the top surface of the recited cover element of Claim 16. Furthermore, the aforementioned limitations of Claim 16 are not taught or suggested anywhere by Takahata et al. Accordingly, Applicants respectfully submit that a cover element such as is delimited in Claim 16 is not taught or suggested by Applicants' Prior Art Figure 1 in view of Takahata et al. Applicants respectfully submit that the aforementioned limitations of Claim 16 are not addressed in the outstanding Office Action. Consequently, a proper motivation for making a modification could not have been provided. It should be noted that the fact that this limitation had not been addressed in the Office Action previous to the outstanding Office Action was pointed out by Applicants in the previous response at page 11.

In summary, Applicants respectfully submit that rejections of Claims 1-20 are improper as the teaching or suggestion of the above discussed limitations needed for proper prima facie rejections of Applicants' Claims are not provided as outlined above. Moreover, because the aforementioned limitations of independent Claims 1, 9 and 16

(from which Claims 2-8, 10-15 and 17-20 depend) are not met by Applicants' Admitted Prior Art in view of Takahata et al., Applicants respectfully submit that the rejection of Claims 1-20 under 35 USC 103(a) as being unpatentable over Applicants Admitted Prior Art in view of Takahata et al. should be reversed.